REMARKS

In the Office Action, the Examiner rejected claims 1, 2, 4-19, 21-24, and 26-86. Applicants canceled claims 3, 20, and 25 in a previous communication. By the present Response, Applicants amend claims 1, 8, 29, 32, 50, 56, 73, and 78 to further clarify the claimed subject matter. Upon entry of the amendments, claims 1, 2, 4-19, 21-24, and 26-86 will remain pending in the present patent application. Applicants respectfully request reconsideration of the above-referenced application in view of the following remarks.

Interview Summary

Applicants thank the Examiner for his participation in telephonic interviews with Applicants' representative on January 8, 2007, and January 10, 2007. In these interviews, the claims of the present patent application and the prior art of record were generally discussed. Particularly, Applicants' representative and the Examiner discussed the Keith et al. and Dekel et al. references, and proposed amendments to claim 1 that more particularly point out and distinctly claim certain subject matter which Applicants regard as their invention. The Examiner noted an initial belief that the prior art of record did not appear to teach or disclose the subject matter of the proposed amendments to claim 1, but indicated that further consideration would be required before any final determination could be made. By the present Response, independent claim 1 has been amended in the discussed manner. Further, independent claims 29, 50, and 73 have been amended in a manner similar to that discussed with respect to independent claim 1. For the reasons provided below, these independent claims, as well as their respective dependent claims, are believed allowable over the prior art of record. Should the Examiner, however, believe that further clarification is necessary, Applicants respectfully request that the Examiner contact the undersigned to discuss the present claims.

Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 2, 4, 5, 7-12, 19, 21-24, 26-36, 40-63, and 73-86 under 35 U.S.C. § 102(e) as anticipated by Keith et al. (U.S. Patent No. 5,881,176). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention "*in as complete detail as contained in the ... claim*" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

Omitted Features of Independent Claim 1, 29, 50, and 73

Turning now to the present claims, the Keith et al. reference fails to disclose each element of independent claims 1, 29, 50, and 73. For instance, independent claim 1, as amended, recites "selecting an image resolution ... wherein the image resolution is determined via an *iterative process* that comprises determining *whether scaling of one of the different image resolutions ... by a predetermined scaling threshold would result in a scaled image resolution that is less than or equal to the resolution of the desired viewport*" (emphasis added). Applicants further note that independent claims 29, 50, and 73 have also been amended to contain similar recitations. Because the Keith et al. reference fails to disclose such elements, the cited reference fails to anticipate the instant claims.

The Keith et al. reference generally relates to the field of data compression and decompression. Col. 1, lines 15-19. The cited reference discloses, among other things, the use of reversible wavelet transforms to decompose an image. *See, e.g.,* col. 11, line 16 – col. 18, line 37. The reference also contains various teachings related to the encoding and decoding of a codestream containing coefficients generated from the application of the wavelet transforms. *See, e.g.,* col. 18, line 40 – col. 26, line 15. However, as discussed with the Examiner, and upon further review, the Keith et al. reference simply does not appear to provide any teaching that can be reasonably equated with the use of the iterative process and scaling threshold disclosed and claimed in the present application. Because the cited reference apparently fails to teach each and every element, it is believed that the Keith et al. reference cannot anticipate independent claims 1, 29, 50, and 73, or their respective dependent claims.

For at least these reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 and allowance of claims 1, 2, 4, 5, 7-12, 19, 21-24, 26-36, 40-63, and 73-86.

Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 13-18 and 37-39 under 35 U.S.C. § 103(a) as unpatentable over Keith et al. in view of Bradley (U.S. Patent No. 5,710,835). The Examiner also rejected claim 6 under 35 U.S.C. § 103(a) as unpatentable over Keith et al. in view of Sodagar et al. (U.S. Patent No. 6,157,746), and rejected claims 64-72 under 35 U.S.C. § 103(a) as unpatentable over Keith et al. in view of Cooke, Jr. et al. (U.S. Patent No. 6,574,629) Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Deficiencies of the Rejections

Applicants note that each of claims 6, 13-18, 37-39, and 64-72 depends from one of independent claims 1, 29, or 50. As discussed above, the Keith et al. reference fails to disclose each element of independent claims 1, 29, and 50. Further, neither the Bradley reference, nor the Sodagar et al. reference, nor the Cooke, Jr. et al. reference is believed to obviate the deficiencies of the Keith et al. reference. As a result, dependent claims 6, 13-18, 37-39, and 64-72 are allowable on the basis of their dependency from a respective allowable independent claim, as well as for the subject matter separately recited in these dependent claims. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 6, 13-18, 37-39, and 64-72.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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